

APPENDIX G-1: SAMPLE JOINT VENTURE AGREEMENT

This joint venture agreement is entered into by and between the parties identified in Exhibit A.

Whereas, the Parties have been selected for participation in the Advanced Technology Program administered by the National Institute of Standards and Technology ("NIST") as a joint venture to conduct certain specified research;

Whereas, the Parties wish to enter into a joint venture agreement to define their respective roles and responsibilities and thus successfully satisfy the objectives of the Program; and

Whereas, the Parties have selected _____ to serve as the Administrator (the "Administrator") for the joint venture and wish to authorize that organization to perform certain functions, specifically including executing the NIST Cooperative Agreement and thereby binding all the Parties to the terms and conditions of that Agreement;

Now, therefore, the Parties agree as follows:

Article 1: Definitions .

1.1 *Agreement* means this Joint Venture Agreement.

1.2 *Background Technology* means technical information not generated in the course of the Program.

1.3 *Government Use License* means a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced by or on behalf of the United States throughout the world any Subject Invention.

1.4 *NIST Cooperative Agreement* means the funding agreement entered into between the Advanced Technology Program of the National Institute of Standards and Technology (NIST) and the Parties (as executed by the Administrator) for the conduct of the Research Program.

1.5 *Party* or *Parties* means the parties identified in the Form NIST-1263 contained in the Proposal and attached to this Agreement as Exhibit A.

1.6 *Patents* means all patents and applications relating thereto resulting from Subject Inventions.

1.7 *Program* or *Research Program* means the research program set forth in Part 3 of the Proposal and included here as Exhibit B.

1.8 *Proposal* means the proposal submitted by the Parties to the Advanced Technology Program, and which has been accepted by the NIST for funding.

1.9 *Subject Invention* means any invention conceived or first reduced to practice in the course of the Program.

1.10 Technology means all technical information generated in the course of the Program.

Article 2: Administration and Governance.

2.1 Obligations of the Parties. The parties agree to work together to accomplish the objectives of the Program by performing research directly and through the use of contracts, and to that end agree to carry out their responsibilities as set forth in the Program, the NIST Cooperative Agreement, and the Statement of Work. The Statement of Work is attached to this Agreement as Exhibit C. The Parties agree to contribute funds or in kind services in the amounts set forth in the Form NIST-1263 contained in the Proposal, attached here as Exhibit D.

2.2 Program Management. The Administrator shall perform the day-to-day management and administration of the Program in accordance with all legal and regulatory requirements, including the NIST Cooperative Agreement.

2.3 Management Committee. The Management Committee, composed of one representative of each Party, shall direct the conduct of the Program in all respects, through the Administrator.

Article 3: Proprietary Information. Each of the Parties agrees that it will not, either during the term of this Agreement or at any time after its termination, use Technology or Background Technology of another Party for any purpose except the Program and the commercial exploitation of the results of the development work of the Program and it will not divulge such Background Technology to any person without the prior written consent of the disclosing Party; provided, however, Background Technology shall not be considered proprietary which:

3.1 Is in the public domain at the time of disclosure or thereafter enters the public domain other than through a breach of this Agreement; or

3.2 Is in the possession of the receiving Party prior to its receipt from the disclosing Party; or

3.3 Is lawfully obtained from a third party under circumstances permitting the receiving Party to use or disclose the information without restrictions; or

3.4 Is independently developed by the receiving Party; or

3.5 Is required to be disclosed as a result of governmental or judicial action.

Article 4: Intellectual Property. The protection of intellectual property rights including Subject Inventions, Technology and trade secrets under the Research Program will be in accordance with the NIST Cooperative Agreement and the Proposal which is summarized and attached to this Agreement as Exhibit E, but shall include provisions effecting the required Government Use License.

Article 5: Term. This Agreement shall continue in full force and effect until the Parties' obligations as set forth in this Agreement and the NIST Cooperative Agreement have been completed, or until the NIST

Cooperative Agreement has been terminated. An individual Party may cease participation in the Program only in a manner consistent with the NIST Cooperative Agreement.

Article 6: Liability, Warranty, Insurance.

6.1 **Liability.** Each Party acknowledges that it shall be responsible for any loss, cost, damage, claim or other charge that arises out of or is caused by the actions of that Party or its employees or agents. No Party shall be liable for any loss, cost, damage, claim or other charge that arises out of or is caused by the actions of any other Party or its employees or agents. Joint and several liability will not attach to the Parties; no Party is responsible for the actions of any other Party, but is only responsible for those tasks assigned to it and to which it agrees in the Statement of Work contained in Exhibit C, or in the NIST Cooperative Agreement. The Parties agree that in no event will consequential or punitive damages be applicable or awarded with respect to any dispute that may arise between or among the Parties in connection with this Agreement.

6.2 **Insurance.** Each Party agrees to obtain and maintain appropriate public liability and casualty insurance, or adequate levels of self insurance, to insure against any liability caused by that Party's obligations under this Agreement and the NIST Cooperative Agreement.

Article 7: Notices. Any notice or request with reference to this Agreement shall be made by first class mail postage prepaid, telex, or facsimile to the addresses shown in Exhibit F.

Article 8: General Provisions .

8.1 **Amendments.** No amendment or modification of this agreement shall be valid unless made in writing and signed by all parties.

8.2 **Assignment.** This agreement shall not be assigned by any Party without the express written consent of the other Parties, which consent shall not be unreasonably withheld. This provision shall not apply in the event a Party changes its name or as part of the sale of the Party's business.

8.3 **Effective Date.** This agreement shall be effective as of the date of the last signature below.

8.4 **Force Majeure.** No Party shall be liable, in respect to any delay in completion of work hereunder or of the non-performance of any term or condition of this Agreement directly or indirectly resulting from delays by Acts of God; acts of the public enemy; strikes; lockouts; epidemic and riots; power failure; water shortage or adverse weather conditions; or other causes beyond the control of the Parties. In the event of any of the foregoing, the time for performance shall be equitably and immediately adjusted, and in no event shall any Party be liable for any consequential or incidental damages from its performance or non-performance of any term or condition of this agreement. The Parties shall resume the completion of work under this Agreement as soon as possible subsequent to any delay due to force majeure.

8.5 **Governing Law.** This Agreement shall be governed by and interpreted in accordance with the laws of _____.

8.6 **Headings.** Article and section headings contained in this Agreement are included for convenience only and form no part of the agreement among the parties.

8.7 **Power of Attorney.** By signing this Agreement, Member grants to Administrator a Power of Attorney for the sole purpose of binding Member to the terms and conditions of the NIST Cooperative Agreement.

8.8 **Precedence.** Should there be any conflict between the terms and conditions of this Agreement and the NIST Cooperative Agreement, the NIST Cooperative Agreement shall take precedence.

8.9 **Severability.** If any provision of this Agreement is declared invalid by any court or government agency, all other provisions shall remain in full force and effect.

8.10 **Use of Names.** No Party shall use in any advertising, promotional or sales literature the name of any other Party without prior written consent.

8.11 **Waivers.** Waiver by any Party of any breach or failure to comply with any provision of this Agreement by another Party shall not be construed as, or constitute, a continuing waiver of such provision or a waiver of any other breach of or failure to comply with any other provision of this Agreement.

In Witness Whereof, the Parties have caused this Agreement to be executed by their duly authorized officers or representatives on the dates shown below.

Name: _____ Name: _____

Title: _____ Title: _____

Date: _____ Date: _____

Name: _____ Name: _____

Title: _____ Title: _____

Date: _____ Date: _____

Exhibits

Exhibit A: Parties to the Agreement.

Exhibit B: Research Program.

Exhibit C: Statement of Work.

Exhibit D: Contributions of the Parties.

Exhibit E: Intellectual Property Plan.

Exhibit F: List of Names and Addresses for Notices Concerning this Agreement

APPENDIX G-2: SAMPLE INTELLECTUAL PROPERTY PLAN FOR JOINT VENTURE AGREEMENT

[NOTE: This sample is not meant to suggest a preferred scheme for the distribution of intellectual property rights among the parties. It is offered to assist the parties in the preparation of their intellectual property plan. Please note that items 4 and 5 below are required in all ATP Joint Venture Agreements].

Exhibit E: Intellectual Property

1. Intellectual property developed solely by an employee or employees of a Party in the performance of the award will be owned by that Party.
2. Intellectual property developed jointly by an employee or employees of one Party with an employee or employees of another Party or Parties in the performance of the award will be jointly owned by those Parties.
3. The Parties hereby offer licenses to each other for the intellectual property described in (1) and (2) above under the following conditions:

[Insert conditions under which the Parties will be able to use the intellectual property of other Parties, e.g., will they pay royalties, will licenses be exclusive or nonexclusive, etc.]
4. Title to any intellectual property arising from assistance provided by the Program shall vest in a company or companies incorporated in the United States. Title to any such intellectual property shall not be transferred or passed, except to a company incorporated in the United States, until the expiration of the first patent obtained in connection with such intellectual property.
5. The Parties understand that the United States will reserve a nonexclusive, nontransferable, irrevocable paid-up license, to practice or have practiced on behalf of the United States any intellectual property arising from assistance provided by the Program, but shall not in the exercise of such license, publicly disclose proprietary information related to the license. The Parties grant to the Government, and others acting on its behalf, a paid up, nonexclusive, irrevocable, worldwide license for all data first produced in the performance of the award to reproduce, prepare derivative works, perform publicly and display publicly, and for data other than computer software to distribute to the public by or on behalf of the Government.

